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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/558,547	10/23/2006	Hong Lin	CN920030005US1	5750
877 7590 11/25/2008 IBM CORPORATION, T.J. WATSON RESEARCH CENTER P.O. BOX 218 YORKTOWN HEIGHTS, NY 10598				
EXAMINER				
PITT, BRYAN W				
ART UNIT		PAPER NUMBER		
4172				
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11/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/558,547

**Applicant(s)**

LIN ET AL.

**Examiner**

Bryan Pitt

**Art Unit**

4172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 29 November 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

***Pre-Amendment***

1. Please note that this action reflects the changes included in the pre-amendments filed on November 29, 2005 and April 2, 2008.

***Drawings***

2. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because they are unreadable. The shading in the figures is too dark to allow the characters to be read and the details of the invention to be understood. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

4. The abstract of the disclosure is objected to because of the use of legal terminology. In the abstract the form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. Correction is required. See MPEP § 608.01(b).
5. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. The XML tags on pages 15-17 of the specification are considered "browser-executable code." Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

#### ***Claim Objections***

6. Claim 1 is objected to because it is generally narrative and difficult to understand in its present arrangement. To improve readability, place the further limitations on the steps of page generation, control element relationship, etc. near the steps they limit and place the steps in chronological order.

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the applicant uses the phrase “listening in the triggered action events” is indefinite as it is unclear what or who is listening and how the listening takes place. Is the listening being done by a human or by a machine? If by a machine, is it an active monitoring, or a passive waiting? For the purposes of examination, Examiner has assumed that a machine is passively waiting for an action event to trigger.

#### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 1 is provisionally rejected on the ground of nonstatutory double patenting over claims 1-7 of copending Application No. 12/128055. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: An interactive method for multimedia message services comprising the steps of: receiving a multimedia message from a server; generating a page displaying or playing the multimedia message at a user terminal, wherein one or more control elements are embedded into the displayed or played multimedia message and the relationship between said control elements is defined; responsive to the operation of one or more of said control elements, triggering an action event to automatically generate a response message to request a service from the server; sending the response message to the server, wherein the step of generating the page for displaying or playing a multimedia message further includes: parsing the received multimedia message to obtain the presentation structure of said multimedia message; and generating a data model used in the page for displaying or playing said multimedia message based on said multimedia message presentation structure; triggering an action event to modify the content of said multimedia message; in response to the operation of said control elements, displaying or playing said modified content of said multimedia message, wherein said relationship includes at least one of a LINK relationship and a CONTAIN relationship; parsing the received multimedia message to obtain an action list of related action rules; listening in the triggered action events based on said action list, wherein said multimedia message is composed in the language forms of XForms, XML, SMIL, XHTML or HTML, and wherein a control element includes one of a submit button, a selective button, a radio button, a check box, a text, a text field, a list box, an option menu.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use these features together as the benefits of using the sum of these features is greater than or equal to the benefits of using the features independently.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Salmi et al. US 2001/0040900 in view of Schwartz et al. US 6,473,609.

Regarding claim 1, Salmi discloses an interactive method for multimedia message service comprising the steps of: receiving a multimedia message from a server (Fig. 4b, "reception of message"); generating a page displaying or playing the multimedia message at a user terminal (i.e. contents of message are converted to visual information and audible sound, paragraph 0054), wherein one or more control elements are embedded into the displayed or played multimedia message and the relationship between said control elements is defined (i.e. links to other pages are embedded in the multimedia page, paragraph 0045); wherein the step of generating the page for displaying or playing a multimedia message further includes: parsing the

received multimedia message to obtain the presentation structure of said multimedia message (i.e. multimedia message is dismantled (parsed) to identify multimedia elements and presentation parameters, Salmi paragraph 0052); and generating a data model used in the page for displaying or playing said multimedia message based on said multimedia message presentation structure (presentation parameters are used to create compatible content, Salmi paragraph 0053-0054); parsing the received multimedia message to obtain an action list of related action rules; listening in the triggered action events based on said action list (i.e. Salmi describes links to other pages (control elements) that are components of the multimedia message. The message will be parsed and presented and then the terminal waits for a command to follow a link and change the page, paragraph 0055); wherein said multimedia message is composed in the language forms of XForms, XML, SMIL, XHTML or HTML (i.e. the multimedia page (message) is in SMIL format, Salmi paragraph 0044); but does not disclose: responsive to the operation of one or more of said control elements, triggering an action event to automatically generate a response message to request a service from the server; and sending the response message to the server; triggering an action event to modify the content of said multimedia message; and in response to the operation of said control elements, displaying or playing said modified content of said multimedia message; wherein said relationship includes at least one of a LINK relationship and a CONTAIN relationship; or wherein a control element includes one of a submit button, a selective button, a radio button, a check box, a text, a text field, a list box, an option menu.

However, the preceding limitations are known in the art of communications. Schwartz discloses the steps of: receiving a multimedia message from a server (Fig. 9E, item 959, Col. 20, lines 32-35); generating a page displaying or playing the multimedia message at a user terminal

(e.g. Col. 2, line 66), wherein one or more control elements are embedded into the displayed or played multimedia message and the relationship between said control elements is defined; responsive to the operation of one or more of said control elements, triggering an action event to automatically generate a response message to request a service from the server; sending the response message to the server (i.e. an indicator is embedded into the message and mapped to a soft key (control element), and when the key is pressed (action event) the mobile device sends a request to the server to display the next screen (request a service), Col. 13, lines 26-32); triggering an action event to modify the content of said multimedia message; and in response to the operation of said control elements, displaying or playing said modified content of said multimedia message (i.e. when a key corresponding to a down arrow indicator (control element) is pressed (action event) each line of the display is rolled up (modified message content displayed in response to operation of control element), Schwartz Col. 13, lines 47-51); wherein said relationship includes at least one of a LINK relationship and a CONTAIN relationship (i.e. the menu items of Schwartz Fig. 7B and 7D exhibit a LINK relationship as when one menu item is displayed, the others are displayed at the same time. See further, Schwartz Col. 13, lines 39-40, Col. 17, lines 3-6); wherein a control element includes one of a submit button, a selective button, a radio button, a check box, a text, a text field, a list box, an option menu (e.g. multimedia message may include an input text field, Schwartz Fig. 7E-7F, Col. 17, lines 16-24).

Schwartz describes using a compressed form of HTML to reduce the bandwidth needed to transmit messages and the processor and memory requirements of the mobile device receiving the message (Schwartz, Col. 7, lines 42-46, Col. 9, lines 59-61). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the features of Salmi with

Schwartz because the reductions of Schwartz allow for cheaper handsets and more users on a network and thus would generate more revenue for cell phone carriers.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jackson et al. US 2004/0039789, discloses sending HTML format multimedia messages with embedded control elements from a multimedia message service (MMS) server to a handset. Teeple et al., US 2002/0120779, discloses using HTTP and markup languages (e.g. HTML, XML, etc) to transmit MMS messages to mobile phones. Wenocur et al. US 2002/0199096, discloses a system and method of receiving multimedia messages, parsing method to obtain a presentation model, playing the multimedia message, waiting for a user action and generating a response request to a server. Vaananen US 7,369,864 discloses receiving and displaying a MMS message and then waiting for a triggering action to display modified content. Novak et al., "MMS—Building on the success of SMS", Ericsson Review, Ericsson, Stockholm, SE, no. 3, 2001, pages 102-109, discloses using MMS to send synchronized presentations using SMIL. Pihkala et al., "Design of a Dynamic SMIL Player", Proceedings 2002 IEEE International Conference on Multimedia and Expo, Vol. 2, 26 August 2002, pages 189-192, discloses LINK relationships in an SMIL document. Mostafa, "MMS – The Modern Wireless Solution for Multimedia Messaging", The 13th IEEE International Symposium on Personal, Indoor and Mobile Radio Communications, 2002, Vol. 5, 15-18 September 2002, pages 2466-2472, discloses obtaining the presentation structure from SMIL.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Pitt whose telephone number is 571-270-7466. The examiner can normally be reached on Monday - Friday 7:30 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis West can be reached on 571-272-7859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. P./  
Examiner, Art Unit 4172

/Lewis G. West/  
Supervisory Patent Examiner, Art Unit 4172